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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/024,387

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7590

08/04/2006

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EXAMINER

VRETTAKOS, PETER J

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/024,387

Applicant(s)

VAN DUREN ET AL.

Examiner

Peter J. Vrettakos

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 100-111 is/are pending in the application.
- 4a) Of the above claim(s) 102-104 and 108-110 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 100,101,105-107 and 111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

**The action is non-final. New art (Dunfee 5,724,993) is presented showing a thermal inflation device with check valves as those seen in Huber (3,565,099).**

The application is published application number: 2002/0058974.

The effective filing date of this application is 4-10-2000. No earlier filing date is granted as the inventions in the currently elected claims are not in an earlier application.

Pending claims are 100-111.

Elected claims 100-101, 105-107 and 111 are and are examined below.

Non-elected / withdrawn claims are 102-104 and 108-110.

Cancelled claims are 1-99.

**Note: The Office relies on figures 14a and 14b in its apprehension of the claims.**

**Element 138 is a hinge lever and elements 139a and 139b are magnets.**

Formal drawings are filed (5-12-06) and accepted.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 100 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunfee (5,724,993) in view of Huber (3,565,099).**

Dunfee discloses an inflatable thermal device (10 with 50) inherently with an inlet port for coupling with an air hose and a **check valve** system (col. 16:59-64). *Dunfee provides no additional description of a **check valve**.*

Huber discloses a structure and method for controlling airflow (12) comprising: the end of an air hose (B – right hand side in figure 1), an inlet port (B – left hand side in figure 1) (obviously connected to an inflatable device such as that in Dunfee), a **check valve** (A) with a flap (15), and a hinge lever (18) for manipulating the valve flap (attached to plug D, col. 2:1-10) as desired.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Dunfee by including the **check valve** as described in Huber the motivation being found in Dunfee col. 16:59-64, “to prevent over-inflation”.

**2. Claims 101, 105, 107 and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunfee (5,724,993) in view of Huber (3,565,099) and further in view of Paidosh (5,716,271).**

Dunfee and Huber are silent regarding magnets. (Huber does however address the need to keep the valve flap shut through the use of a simple counterweight (21).)

However, in an analogous device/method depicted in figure 1, Paidosh discloses magnets (18,24,28,36,44) as well as the fact that magnets are superior to the gravity driven counterweight (col. 4:30-40) as seen in Huber.

The motivation to combine the patents is to keep the valve flap shut and is found in Paidosh last limitation of patented claim 1.

Therefore, at the time of the invention in would have been obvious to one of ordinary skill in the art to modify the Huber in view of the supporting reference by Paidosh. Again, the motivation to combine the patents is to use a superior way (see Paidosh col. 4:30-40) to keep the valve flap shut and is found in Paidosh last limitation of patented claim 1.

### ***Response to Arguments***

Applicant's arguments filed 5-8-06 have been fully considered. In response, new obviousness rejections are submitted.

The Applicant argues that an air hose as mentioned in a single embodiment (amongst many others) in the specification includes a flexible sidewall and that Huber discloses a rigid pipe B thereby obviating the above rejections. The Applicant is directed to *Merck & Co., Inc., v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370, 73 USPQ2d 1641, 1646 (Fed. Cir. 2005), where the court held that patentee failed to redefine the ordinary meaning of "about" to mean "exactly" in clear enough terms to justify the counterintuitive definition of "about." ("When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he

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must clearly express that intent in the written description." ). Applied to the instant case, an air hose is defined universally as a tubular element. The amount of rigidity in the tube does not by itself preclude a tube from being called an air hose. Otherwise would be "counterintuitive". For an example of a "rigid air hose" see USPN 5,819,857 Rohrer element 85. Further, the Applicant has not provided an express intent to redefine the claimed term "air hose" to preclude a rigid tube and as such, remaining consistent with the court ruling, the Office asserts it fair the statement that Huber discloses an "air hose" (B) regardless of its rigidity.

The Applicant argues no thermal inflation device in Huber. **In response, Dunfee is presented above in which a thermal inflation device (10) is disclosed as well as check valves (col. 16:59-64) such as that in Huber.**

The Applicant argues that Huber valve A is disposed outside the end of the right hand pipe B and not in the pipe. The Office has two responses. First, the claim can in addition to the Applicant's apprehension also include the apprehension that it is the flap alone (and not the valve also) that is disposed in the air hose. Second, the difference in Huber's disclosure flap 15/valve A outside the hose B and the Applicant's disclosure of a flap/valve inside the hose is mere reversal of parts. The MPEP addresses this:

**MPEP § 2144.04 VI. A. Reversal of Parts**

*In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955) (Prior art disclosed a clock fixed to the stationary steering wheel column of an automobile while the gear for winding the clock moves with steering wheel; mere reversal of such movement, so the clock moves with wheel, was held to be an obvious expedient.).

In this spirit, the Office asserts that placing the flap 15/ valve A inside the hose B would be an obvious design expedient. This is reflected in the obviousness rejection above.

The Applicant argues that no means for opening the flap is identified. The Office directs the reader to element 18 – a hinge lever. Element 18 is near the end of the hose B and *permits the user to open the flap 15 in response to the inlet port* (from Dunfee 10) coupling with the air hose.

The Applicant argues that Huber omits “the hinge lever cooperating with the inlet port to prevent the flap from blocking airflow.” This is incorrect. The hinge lever 18 turns plug D and flap 15 to prevent (or allow) airflow through the inherent inlet port (from Dunfee) as the user sees fit. See Huber figures 1 and 2.

The Applicant argues that Huber omits “in response to decoupling, moving the flap to block airflow through the one end.” Although this step might not be expressly disclosed, it is wholly obvious that when a user decouples an airflow system, that user shuts off a valve to prevent further airflow. Moreover, there are only two positions in which the flap 15 can be configured (open or shut as determined by air flow direction and position of handle 18). Through routine experimentation, a user would determine it optimal to close/shut the valve/flap upon decoupling the inflation device from its prior attached air hose.

The Applicant argues that Huber’s disclosure of a counter-weight 21 raises no suggestion for additional means to hold the flap 15 closed. The reader is directed to *In re Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 (“The normal desire of scientists or

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artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.""). Although the instant application is not concerning percentages, what the case law teaches is that artisans contain a normal desire to improve upon what is already known. Paidosh teaches away from gravity based flap valves because as implied by Paidosh, a magnetic open and shut system would be an improvement of the sort referred in *Peterson* above. MPEP § 2144.05 strengthens this optimization/improvement argument as confirmed through routine experimentation, thereby increasing the likelihood that one of ordinary skill would use magnets in the Huber valve (after confirming Paidosh's statements regarding magnets through routine experimentation) because Paidosh asserts the superiority of the magnet system over the gravity based counterweight in Huber. As such, the rejection is maintained.

The Applicant argues that Paidosh has only one magnet, whereas the claims require two magnets. The MPEP addresses this:

**MPEP § 2144.04 VI. B. Duplication of Parts**

*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies \*\* in the joint, and a plurality of "ribs" \*\* >projecting outwardly from each side of the web into one of the adjacent concrete slabs. <The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.).



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As such, the Office asserts that because no new and unexpected results as a result of additional magnets are produced by the Applicant, additional magnets in the claims have no patentable significance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
August 1, 2006

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MICHAEL PEFFLEY  
PRIMARY EXAMINER